

REMARKS

The examiner has required restriction of the application under 35 U.S.C. § 121. Specifically, the examiner has required Applicant to elect between the inventions of:

Group I, Claims 1-13, drawn to a transmitter and receiver, classified in class 119, subclass 720;

Group II, Claims 14-16, drawn to a process of controlling stimulation, classified in class 340, subclass 540; and

Group III, Claims 17-28, drawn to a method of training an animal, classified in class 119, subclass 712.

Applicant acknowledges the restriction requirement.

The examiner has not provided any comments concerning the Response to the Office Action Mailed March 2, 2005 that was filed on June 1, 2005 as part of this action.

Timing of Restriction Requirement [MPEP § 811]

The Manual of Patent Examining Procedure states:

37 CFR 1.142(a), second sentence, indicates that a restriction requirement "will normally be made before any action upon the merits; however, it may be made at any time before final action." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

MPEP § 811 (Aug. 2005).

In the instant application, action on the merits was made in the Office Action Mailed March 2, 2005 (First Office Action). The examiner rejected Claims 1-28 under 35

U.S.C. § 102(b) as being anticipated by U.S. Patent Number 6,170,439). Applicant filed a response to the First Office Action on June 1, 2005.

The examiner has not established that restriction of the application is proper. A proper restriction requirement must state

(A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required

MPEP § 808 (Aug. 2005). In the First Office Action, the examiner cited two references, U.S. Patent Number 6,598,563 (US Class 119/720) and U.S. Patent Number 5,815,077 (U.S. Class 340/573.3). However, the patent used to reject all claims was provided to the examiner in the Information Disclosure Statement provided by Applicant. Based on the prosecution history to this point, it does not appear that the examiner was seriously burdened in examining the claims of the instant application at the time of the first action. The examiner has not shown why restriction is necessary at this point in the prosecution to avoid serious burden. Accordingly, the restriction requirement is not proper. Applicant respectfully requests that the examiner withdraw the restriction requirement.

Restriction Requirement - Product and Process of Use [MPEP § 806.05(h)]

Notwithstanding the lack of serious burden, Applicant respectfully submits that the examiner has failed to establish that inventions are distinct. Restriction is only proper when each invention is able to support separate patents and the inventions are either independent and/or distinct. MPEP § 803 (Aug. 2005). An application containing two or more "independent and distinct" inventions may be restricted to a single invention. 35 U.S.C. § 121 (2000). Two inventions are independent if they are unconnected in design, operation, and effect. MPEP § 802.01 (Aug. 2005). Even if

related, two inventions that are “not connected in at least one of design, operation, or effect ... and wherein one invention is patentable ... over the other” are distinct. *Id.*

The Manual of Patent Examining Procedure states that

[a] product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

MPEP § 806.05(h) (Aug. 2005).

Groups I and II

Groups I and II are not a product and a process for use as alleged by the examiner. Group I includes four independent product claims, Claims 1, 6, 8, and 11. Group II includes a single independent computer program product claim, Claim 14. *See In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). The examiner has not properly established that the Groups I and II are distinct inventions or that examining both Groups I and II would place a serious burden on the examiner. Therefore, the restriction between Groups I and II is not proper. Applicant respectfully requests that the examiner withdraw the restriction requirement between Groups I and II.

Groups I and III

At the outset, Applicant notes that the examiner has stated that Group I is classified at U.S. Class 119/712 (Animal Controlling or Handling) and Group III is classified at U.S. Class 119/719 (Mechanical wave producing device). Subclass 719 is organized under subclass 712. The examiner has provided any reason as to why a serious burden would result from not making the restriction requirement.

With respect to Groups I and II, the examiner has alleged that the inventions are distinct because the “apparatus as claimed could be used to generate a continuous signal thereby producing a shock or audible stimulation absent any verification step for use in keeping an animal at a prescribed distance from an object.” Paper Number 20051003, App. No. 10/817,602 at 2, 3 (Oct. 7, 2005). In order to support a restriction requirement, the alleged alternate use of the product must be materially different from the use claimed in the process. *See* MPEP § 806.05(h).

The product of Group I is not capable of producing a continuous signal resulting in a stimulation without verification as suggested by the examiner. Each of the independent claims in Group I specifically call for the generation and/or decoding of a coded signal in order to produce the desired stimulation. Further, Claims 6 and 8 of Group I expressly include a limitation pertaining to verification/identification in contradiction to the examiner’s allegedly materially different alternate use.

Because the examiner has failed to establish that a serious burden exists necessitating the restriction and the alternate use suggested by the examiner cannot be accomplished, Applicant respectfully requests that the restriction requirement between Groups I and III be withdrawn.

Restriction Requirement - Subcombinations Usable Together [MPEP § 806.05(d)]

With respect to Groups II and III, the examiner has alleged that the inventions are subcombinations that can be shown to be separately usable. Specifically, the examiner has alleged that invention of Group III has “separate utility such as using a processing unit which delivers a single control signal where the type of stimulation requested is controlled by the variation in the amplitude or frequency of the control signal.” Paper Number 20051003 at 3.

First as previously noted, Group II is a single product claim and Group III is a process. Therefore, the examiner's suggestion that the inventions of Groups II and III are subcombinations with separate utility is inaccurate. Accordingly, Applicant respectfully requests that the restriction requirement between Groups II and III be withdrawn.

Amendments to the Claims

Applicant has amended Claims 19, 21, and 22 to correct typographic errors in the numbering of the method steps.

Election

In the event that the examiner maintains the restriction requirement, Applicant hereby elects Group II, corresponding to Claims 14-16, with traverse, and withdraws Claims 1-13 and 17-28. However, upon allowance of the Claims of Group II, it is respectfully requested that the claims of Group I, Claims 1-13 and Group III, Claims 17-28, be reentered and allowed.

Conclusion

In view of the arguments presented herein, it is respectfully submitted that the requirement for restriction should be reconsidered and withdrawn, and that Claims 1-13 and 17-28 should be reentered. With the amendments to the claims, it is respectfully submitted that all claims are in a condition for allowance. Alternatively, in view of the election of Group II and withdrawal of Claims 1-13 and 17-28, it is respectfully submitted that the examiner's restriction requirement has been traversed and that Claims 14-16 are in condition for allowance. It is further respectfully submitted that Claims 1-13 and 17-28 are likewise in condition for reinstatement and allowance following allowance of the claims of Group II.

If, however, the examiner is of the opinion that the application is not allowable, it will be appreciated if the examiner will telephone the undersigned to expedite the prosecution of the application. Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ken Hoffmeister". The signature is fluid and cursive, with the first name "Ken" written in a slightly larger, more prominent script than the last name "Hoffmeister".

J. Kenneth Hoffmeister
Reg. No. 43,675

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